



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,353	06/16/2005	Eric F Bernstein	BERN-0082	7199

26259 7590 10/17/2008
LICATA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

EXAMINER

PAGONAKIS, ANNA

ART UNIT	PAPER NUMBER
----------	--------------

1614

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/17/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

poreilly@licataandtyrrell.com

Office Action Summary	Application No. 10/533,353	Applicant(s) BERNSTEIN, ERIC F	
	Examiner ANNA PAGONAKIS	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7 sheets, 5/11/2007; 4 sheets, 4/29/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1614

DETAILED ACTION

Applicant's election with traverse of Group I, claims 1-4, in the reply filed on 7/18/2008 is acknowledged. The traversal is on the ground(s) that lack of unity was not found in the related application and further that all claims were searched during the PCT phase of examination. This is not found persuasive firstly because the standard for a finding of lack of unity is proper when there is no technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. Since there is no contribution over the prior art, there is no common special technical feature amongst the claims. Secondly, reconsideration of the instant claims have found a lack of unity appropriate

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-7 are pending in the application. Claims 5-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subject matter, there being no allowable generic or linking claim.

Claims 1-4 are currently under examination and the subject of this Office Action.

Change of Examiner

The examiner assigned to the instant application has changed. The new examiner is Anna Pagonakis. Contact information is provided at the end of this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1614

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. It is unclear to the Examiner what compounds are “structurally similar to caffeine.” This is not clear because a very limited set of compounds are defined as to which ones fit this description in the specification (page 4, lines 4-20). Routine identification as noted in the instant specification fails to support the written description of additional compounds.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroer (U.S. 3,957,994, provided by Applicant), as evidenced by Perricone (U.S. 5,409,693).

** The below explanation fails to point to support in Perricone regarding the “prior to exposure” limitation in instant claim 3. Should claim 3 therefore be rejected over Perricone?

Schroer teaches a composition comprising theophylline useful in the treatment of inflammation of the skin such as sunburn (abstract and column 2).

It is acknowledged that Schroer does not explicitly teach the protection against photoaging. However, this gap in the reference is properly filled with recourse to extrinsic evidence in accordance with MPEP 2131.01, which states that a secondary reference may be properly applied in a rejection under 35 U.S.C. 102 as long as the second reference is cited to: (1) prove the primary reference contains an

Art Unit: 1614

"enabled disclosure"; (2) explain the meaning of a term used in the primary reference; or (3) show that a characteristic not disclosed in the reference is inherent.

Perricone teaches a wide variety of skin diseases and skin conditions in which the skin has undergone some form of damage or accelerated aging can be traced, either directly or indirectly, to processes which either deplete or inhibit synthesis of collagen, and/or generate oxygen-containing free radicals, and/or oxidatively generate biologically active metabolites, generally via lipoxygenase pathways, which in turn either directly act upon the skin or mediate other processes which have adverse effect on the skin. Such is the case, for example, in radiation-induced skin damage, particularly ultraviolet radiation-induced skin damage (e.g., sunburn) where it appears possible that the transfer of energy from the radiation to the skin results in the generation of excited oxygen species, such as singlet oxygen, the superoxide anion, and hydroxyl radicals, that can damage lipid-rich membranes with the subsequent activation of the chemical mediators of inflammation and/or damage the skin cell membrane and DNA, and also where it appears that the radiation releases arachadonic acid which is then oxidized via two predominant pathways to produce either prostaglandins or leukotrienes. Agents used for prevention and/or treatment of sunburn have been used prior to ultraviolet exposure in order to exert their protective effect (column 4, lines 60-64).

Thus given the teachings of Perricone, the very exposure to sunburn would have necessarily resulted in photoaging which meets Applicant's limitation directed to protection against photoaging.

Conclusion

No claim is found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 9am to 5pm EST.

Art Unit: 1614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AP

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614